REMARKS/ARGUMENTS

This communication is in response to the Non-Final Office Action dated May 13, 2009. Claims 1-3, 12, 16 and 19 have been canceled, without prejudice. Claims 9, 20 and 21 have been amended. New claims 26-28 have been added. No new matter has been added. Claims 4-11, 13-15, 17, 18 and 20-28 are pending in this application, with claims 20, 21 and 25 being the only independent claims. Reconsideration in view of the amendments to the claims and arguments presented below is requested.

Prior Art Claim Rejections

Claims 20 and 6 are rejected under 35 U.S.C. §102(b) as anticipated by German Patent No. 4110015 (Bihusch).

Claims 4, 5, 7-9 and 21 are rejected under 35 U.S.C. §103(a) as obvious over Bihusch in view of US Patent No. 5,903,299 (Kishi).

Claim 25 is rejected under 35 U.S.C. §103(a) as obvious over Japanese Patent No. 07-107574 (Miyazaki et al.) in view of Bihusch.

Claim 13 is rejected under 35 U.S.C. §103(a) as obvious over Miyazaki et al. in view of Bihusch and US Patent No. 5,815,139 (Yoshikawa et al.).

Claim 18 is rejected under 35 U.S.C. §103(a) as obvious over Miyazaki et al. in view of Bihusch, Yoshikawa et al. and US Patent No. 7,190,351 (Goren).

Claims 10 and 22 are rejected under 35 U.S.C. §103(a) as obvious over Bihusch in view of US Design Patent No. D490,405 (Nuovo).

Claims 23 and 24 are rejected under 35 U.S.C. §103(a) as obvious over Bihusch in view of Kishi and Nuovo.

Claim 11 is rejected under 35 U.S.C. §103(a) as obvious over Bihusch in view of Kishi and US Patent No. 6,804,027 (Lee).

Claims 14 and 15 are rejected under 35 U.S.C. §103(a) as obvious over Miyazaki et al. in view of Bihusch and US Patent No. 6,603,708 (Tamagawa et al.).

Claim 17 is rejected under 35 U.S.C. §103(a) as obvious over Miyazaki in view of Bihusch, Yoshikawa et al. and Tamagawa et al..

Applicants respectfully traverse the outstanding rejections for at least the reasons presented below.

Independent Claim 20 & Dependent Claim 27

Claim 20, as amended, calls for "a disc-shaped control element (11) having a circular upper surface (20) and an underside (16), the circular upper surface (20) and the underside (16) being parallel to one another across the entire disc-shaped control element (11)." (emphasis added)

Because the circular upper surface (20) and the underside (16) are parallel to one another across the entire disc-shaped control element (11) nothing projects downward from the underside to impede its movement. In contrast, Bihusch discloses three different embodiments, each of which will be addressed separately. One embodiment (Nr. 2) based on the hatching in this cross sectional view, the top cap has a cross section that clearly shows the upper surface and underside are not parallel across the entire disc-shaped control element due to the central arm and side rim projecting downward from the underside toward the base unit. Another embodiment (Nr. 7) similarly shows the side rim projecting downward from the underside of the top cap towards the base unit. Lastly, the embodiment (Nr. 8) also depicts the side rim projecting downward from the underside of the top cap towards the base unit. Therefore, all embodiments in Bihusch show only a portion of the disc-shaped control element is the upper surface parallel to the underside, rather than across the entire disc-shaped control element as found in claim 20.

Dependent claim 27 contains limitations similar to those found in claim 20 and thus is patentable over the prior art of record for at least the reasons discussed above with respect to claim 20.

Independent Claim 21 & Dependent Claim 9

Claim 21, as amended, calls for "a rotatable actuation disc (22) arranged on the transmission element (26), the rotatable actuation disc (22) having about its perimeter a

downwardly projecting border area (25)" and "an application casing (15), the border area (25) being disposed between but without contacting the disc-shaped control element (11) and the application casing (15)." (emphasis added)

As noted in the specification of the application, "The surface 20 of the control element 11 including a rounded edge 24 is easily reachable with a finger 19, while a border area 25 that is vertical to the surface 20 is not accessible. This is because an actuation of this border area 25 would have no effect with the control element 11 according to the invention." {Specification: p. 8 , ll. 27-31}

Nothing in either Bihusch or Kishi alone discloses or suggests that the rotatable actuation disc has about its perimeter a downwardly projecting border area, much less, that the border area is disposed between but without contacting the disc-shaped control element and the application casing, as found in claim 21. Applicants assert that even if assuming, *arguendo*, the combination of Bihusch and Kishi taught a downwardly projecting border area that border area would be disposed radially outside the bottom cap of Bihusch rather than between the top cap and the bottom cap, as expressly called for in claim 21.

Dependent claim 9, as amended, contain similar limitations to that found in claim 21 and thus is patenable over the prior art of record for at least the reasons discussed above with respect to claim 21.

Claims 25, 13-15, 17, 18, 27 & 28

The Miyazaki et al. primary prior art reference (JP 07 -107574) relied on as the basis for rejecting claims 13-15, 17, 18 and 25 is in Japanese and the only English translation provided was that of the Abstract. Analysis of the drawings can not be obtained without a full translation of the document. Applicants therefore request that a translation of the full text document be supplied in the next office action. MPEP §706.02 (II) provides "It may be appropriate for the examiner to make a rejection in a non-final Office action based in whole or in part on the abstract only without relying on the full text document. In such circumstances, the full text document and a translation (if not in English) may be supplied in the next Office action." Upon receiving the full translation an analysis of the entire disclosure will be made.

As best Applicants representative can understand Miyazaki et al. without a full translation, method claim 25 appears to be distinguishable therefrom because it calls for "actuating a sensor located below the disc-shaped control element thereby registering the tilt"; "connecting the sensor to a micro processor controlling a cursor movement" and "continuing the sliding of the finger over the disc-shaped control element for continued cursor movement." The English abstract of Miyazaki et al. discloses "Plural sensor are internally coupled to the operation part 7 and by detecting the inclining direction, the operating instruction of a user can be detected." Referring to Figure 9 for sensors two X-direction sensors (Xk, Xr) and two Y-direction sensors (Yk, Yu) are used to detect the inclining direction. Therefore, the operation part 7 in Miyazaki et al. fails to "register the tilt" instead detecting only the direction of inclination. Furthermore, since only the inclining direction is detected, Miyazaki et al. fails to disclose or suggest "controlling a cursor movement" or "continued cursor movement" by "continuing the sliding of the finger over the disc-shaped control element", as found in claim 25. If the user of the Miyazaki et al. remote operation controller slides his/her finger over the operation part 7 it would change the direction of inclination rather than effect continued cursor movement.

New dependent claim 28 is further distinguishable over Miyazaki et al. in that it calls for "wherein registering the tilt comprises evaluating the sensors to determine a position of actuation of the control element." (emphasis added) As previously mentioned with respect to claim 25, Miyazaki et al. discloses that the sensors detect the inclining direction, rather than "a position of actuation of the control element." (emphasis added)

Dependent Claim 5

Claim 5 further specifies "wherein the actuation disc (22) is rotatable around an axis (14) of the control element (11) and is pivoted and supported over transmission elements (26) on the surface (20) of the control element (11)." (emphasis added)

The Examiner in rejecting claim 5 maintains that the claimed "transmission elements (26) is taught by "attachments" in Kishi (Col. 1, l. 58 through Col. 2, l. 16) Specifically, the relevant passage from Kishi merely discloses "As shown in FIG. 24, the jog dial input device includes a jog dial 21 rotatably attached to a main body." (Col. 1, ll. 60-61)(emphasis added)

Nothing in Kishi expressly discloses how the jog dial 21 is "rotatably attached" to the main body and thus fails to read on the claimed limitation that the actuation disc (22) be "pivoted and supported over transmission elements (26) on the surface (20) of the control element (11)."

Dependent Claim 26

New dependent claim 26 further specifies "wherein no direct contact exists between the control element (11) and the application casing (15), and the only indirect contact between the control element (11) and the application casing (15) is via the plural springs (17)."

Once again since the only contact (indirect rather than direct) between the control element and application case is via the springs this optimizes movement. To the contrary, Bihusch discloses direct contract between the top cap and base unit in all three embodiments. Specifically, in (Nr. 2) there is direct contact between the top cap and base unit via the central stem/arm that projects downward from the underside of the top cap. As for the other embodiments (Nr. 7) shows the inward side walls project downward from the underside of the top cap and directly contact the side walls of the base unit. Similarly, in the last embodiment (Nr. 8) the inward side walls project downward from the underside of the top cap and directly contact both the side walls and the bottom of the base unit.

For at least the foregoing reasons Applicants submit that claims 4-11, 13-15, 17, 18 and 20-28 are patentable over the prior art of record and passage of this application to issuance is therefore requested.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Respectfully submitted,

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